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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/402,232	09/30/99	ESKUCHEN	R H-2849-PCT/U

023657 HM12/0928
COGNIS CORPORATION
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EXAMINER

LEE, H

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 09/28/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/402,232

Applicant(s)

Eskuchen et al.

Examiner

Howard C. Lee

Group Art Unit

1623



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 11-24 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 11-24 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

Howard C. Lee

Howard C. Lee
Primary Examiner
Art Unit 1623

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Objection

Claim 12 is objected to because of the following informalities: Claim 12 has a typo ("the" at the end of line 2). Appropriate correction is required.

35 U.S.C. 102(b) rejection

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-13, 16-18, 21, 22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Carduck et al. (U.S. Patent #5,554,741).

The applicants' claim is generically directed toward a process of making alkyl or alkenyl oligoglycosides which is comprised of forming a glucose syrup/fatty alcohol suspension to which an acid catalyst has been added. This suspension then undergoes acetalization to form the alkyl or alkenyl oligoglycosides.

Further limitations include:

- (1) solids content of the glucose syrup being 50-85% by weight;
- (2) glucose syrup having a monomeric glucose content of 80-99.9% by weight;
- (3) the fatty alcohol having from 6-22 carbon atoms;
- (4) a glucose syrup:fatty alcohol ratio of 1:1 to 1:10;
- (5) an acid catalyst content of 0.1 to 5% by weight;
- (6) drying the glucose syrup/fatty alcohol suspension prior to acetalization;
- (7) a reaction temperature gradient of 70-120°C.

Carduck et al. teaches a process directed toward making alkyl or alkenyl oligoglucosides which is comprised of forming a glucose syrup/fatty alcohol suspension to which an acid catalyst has been added. This suspension then undergoes acetalization to form the alkyl or alkenyl oligoglycosides.

Further limitations include (see the claims):

- (1) solids content of the glucose syrup being 50-85% by weight;
- (2) use of monomeric glucose syrup (alkyl or alkenyl "*oligoglucosides*" are formed);
- (3) the fatty alcohol having from 6-22 carbon atoms;

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- (4) a glucose syrup:fatty alcohol ratio of 1:2 to 1:10;
- (5) use an acid catalyst (which by definition describes small quantities by weight);
- (6) drying the glucose syrup/fatty alcohol suspension prior to acetalization;
- (7) a reaction temperature gradient of 120-180°C (Example B in col. 3 teaches a reaction temperature of 110°C).

As such, the applicants' claims encompass the teachings of Carduck et al.

<p><i>35 U.S.C. 103(a) rejection</i></p>

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 11-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carduck et al. (supra).

Claims 11-13, 16-18, 21, 22 and 24 are rejected as anticipation is the epitome of obviousness.

Carduck et al. does differ from the applicants process in the following regards:

- (3) scope of fatty alcohols used;
- (4) the lower range of the ratio of glucose syrup:fatty alcohol;
- (5) the lower range of the reaction temperature;
- (8) the glucose is in supercooled melt form;
- (9) the fatty alcohol is preheated at a temperature of 25-40°C
- (10) the process can be carried out discontinuously in a stirred tank reactor or in a cascade of 3-6 stirred tank reactors.

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With regard to (3), (4), (5) and (8), these differences represent routine optimizations of the process conditions which are practicable by the skilled artisan.

With regard to (9) Carduck et al. does teach that the fatty alcohol can be preheated to a temperature of 60°C (see col. 3, lines 11-12) and does not appear to be a critical element of the process as the glucose syrup/fatty alcohol suspension is dried prior to acetalization.

With regard to (10), it has been held that making a process continuous from known teachings of a batch process is obvious, see *In re Dilnot*, 319 F.2d 188, 138 USPQ 248 (CCPA 1963)..

<i>Status of the Claims</i>

No claim is allowed. *Claims 11-24 are rejected.*

<i>Examiner's hours, phone & fax numbers and other useful information</i>

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mr. Howard C. Lee whose telephone number is (703) 308-4626 and e-mail address is Howard.Lee@uspto.gov (NOTE: **The U.S PTO does not accept responsibility for the security of e-mail transmissions by the applicant(s).** Thus, e-mail sent to an examiner should not include confidential information. For further details, see the PTO Internet Usage Policy which has been published in the Federal Register of 21 June 1999, volume 64, number 118.) The examiner can normally be reached on Monday-Friday 0700-1530 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Gary Geist (703) 308-1701, may be contacted. The fax phone number for Group 1600, Art Unit 1623 is (703) 308-4556 or 305-3592.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-1235.

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Secure and confidential access to patent application status is now available; see <http://www.uspto.gov/ebc/index.html> for more information.

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Applicant(s) may pay patent maintenance fees, non-filing application fees and maintain USPTO accounts through <http://www.uspto.gov/web/offices/ac/comp/fin/clonedefault.htm>

Howard C. Lee

Howard C. Lee
Primary Examiner
Art Unit 1623
26 September 2000